

**Remarks*****I. Introduction***

New claims 25-33 are pending in the application. The word “wire” has been removed from the preamble of the claims. Additionally, the word “stainless steel” has been removed from claim 31.

Figures 3 and 4 have been designated by a legend “Prior Art.” Corrected drawings in compliance with 37 CFR 1.121(d) have been submitted and have been labeled as “Replacement Sheet” in the page header.

The specification has been amended to include a cross reference to the other related reissue application of the present divisional reissue application.

Claims 25-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Misselbrook et al. (US 5,638,904).

Claim 25 has been amended. Claims 34-38 have been added. No new matter has been added.

***II. Anticipation Rejection Improper***

Claims 25-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Misselbrook et al. (US 5,638,904).

Anticipation requires that each and every element of the claimed invention be described, either expressly or inherently, in a single prior art reference. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327, 58 U.S.P.Q.2d 1545, 1552 (Fed. Cir. 2001); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, anticipation under section 102 is only valid when a reference shows exactly what is claimed; where there are differences between the references disclosures and the claim, a rejection must be based on obviousness under Section 103. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

**Regarding claim 25:**

Applicant's invention requires that one or more optical fibers have a helical configuration inside the tubing so that the one or more optical fibers have a length longer than the tubing in which the one or more optical fibers extend.

The Action admits that such requirement is "**not mentioned**, but implicitly known since when the tubing is spooled from a reel the optical fiber(s) will yield" (emphasis added). Applicant respectfully disagrees. Misselbrook does not teach that optical fibers will yield in the inner tubing to have a helical configuration inside the inner tubing so that the one or more optical fibers have a length longer than the tubing in which the one or more optical fibers extend.

Although apparently missing from the U.S. Misselbrook patent, the related PCT Application PCT/US97/03563 (WO 97/35093) shows figure 4. Figure 4 illustrates in cutaway section components of coiled-in-coiled tubing. The figure is reproduced below.

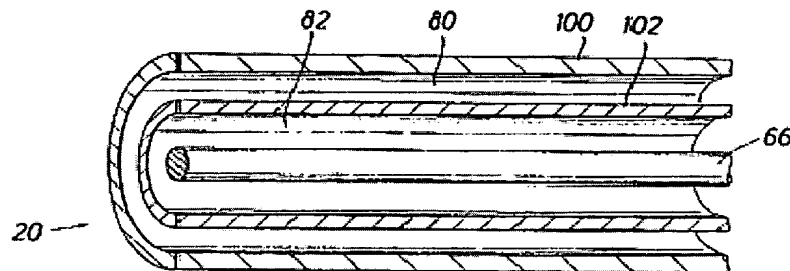


FIG. 4 illustrates cable or wireline 66 contained within inner tubing 102 contained in turn within outer tubing 100. Cable 66 could comprise fiber optic cable for some applications. Contrary to the Examiner's argument, Misselbrook does not teach optical fibers 66 to be in a helical configuration in tubing 102.

Moreover, the Examiner's argument regarding unraveling the coiled-in-coiled tubing 20 from the spool does not make sense. If the tubing 20 is on a spool, the tubing 20 is of a definite length. The tubing 20 is made up of outer tubing 100, inner tubing 102, and the cable 66. Physically, how does the inside cable 66 grow to some length greater than the tubing 102 in which it is placed? Also, how does the cable 66 end-up in a helical configuration within the

tubing 102? Applicant, respectfully submits that this does not occur. Nor does Misselbrook teach that such occurs.

Additionally, applicant's claimed invention requires that the tubing have an outer diameter between 1/8"-1/2". Misselbrook does not teach this feature of Applicant's invention. The Action improperly cites col. 5, lines 24-25. The full paragraph is reproduced below:

The inner coiled tube is envisioned to vary in size between 1/2" (inches) and 5 1/2" (inches) in outside diameter ("OD"). The outer coiled tube can vary between 1" and 6" in outside diameter. A preferred size is 1 1/4 to 1 1/2" O.D. for the inner tube and 2" to 23/8" O.D. for the outer tube.

Misselbrook teaches a range of 1/2" to 5 1/2" for an inner coiled tube, not 1/8" to 1/2".

***Regarding claim 26:***

The Action cites col. 7, lines 37-38 of Misselbrook for the proposition that Misselbrook teaches one or more insulated conductor wires extending along the inner diameter of the tubing. Lines 37-38 read as follows: "Wireline 66 and electrical line 67 can be complex multistranded lines." However, there is no discussion or teaching that such wireline 66 is insulated.

Moreover, Misselbrook does not teach the requirements of parent claim 25, in combination with the requirements of claim 26.

***Regarding claim 27:***

Misselbrook does not teach (and is admitted by the Action) that the one or more insulated conductor wires have a helical configuration inside the tubing so that the one or more insulated conductor wires have a length longer than the tubing in which the one or more insulated conductor wires extend.

Moreover, Misselbrook does not teach the requirements of parent claim 25, in combination with the requirements of claim 27.

***Regarding claim 28:***

Misselbrook does not teach that the tubing is at least 1,000 ft. Rather col. 4, lines 40-41 teaches: “[t]his invention relates to the use of coiled-in-coiled tubing (several hundred feet of a smaller diameter inner coiled tube located within a larger diameter outer coiled tube) to provide a safeguarded method for fluid communication.” Several hundred feet does not come close to meaning at least 1,000 ft. In fact, due to the nature of the invention of Misselbrook using coiled-in-coiled tubing, the weight involved would severely limit the length of the tubing to only several hundred feet.

Moreover, Misselbrook does not teach the requirements of parent claim 25, in combination with the requirements of claim 28.

***Regarding claim 29:***

Misselbrook does not teach that the tubing has an inner diameter less than about two-times the diameter of the one or more insulated conductor wires. The reference made by the Action to col. 8, lines 5-6 is misplaced. It reads as follows: “A typical width for inner tubing 102 is 0.095 inches. A typical width for outer tubing 100 is 0.125 inches.” Absent from the cited portion of Misselbrook is any discussion of the wireline which is reference number 66. The cited section refers an **inner tubing** and an **outer tubing**, not the inner tubing 102 and the wireline 66.

Moreover, Misselbrook does not teach the requirements of parent claim 25 and 26, in combination with the requirements of claim 28.

***Regarding claim 30:***

Applicant agrees that the cited reference of Misselbrook teaches the use of stainless steel for tubing, but does not teach the requirements of parent claim 25 in combination with the requirements of claim 30.

***Regarding claim 31:***

The cited reference in Misselbrook does not teach a tubing made of a nickel alloy.

Moreover, Misselbrook does not teach the requirements of parent claim 25, in combination with the requirements of claim 31.

***Regarding claim 32:***

Applicant agrees that the cited reference of Misselbrook teaches coiled tubing, but does not teach the requirements of parent claim 25 in combination with the requirements of claim 32.

***Regarding claim 33:***

As discussed above, Misselbrook does not teach (and is admitted by the Action) that the one or more optical fibers inside the tubing is supported through frictional interface between an outer surface of the one or more optical fibers and an inner surface of the tubing.

Moreover, Misselbrook does not teach the requirements of parent claim 25, in combination with the requirements of claim 33.

Accordingly, Applicant respectfully requests that the rejection of claims 25-33 under 35 U.S.C. § 102(b) as anticipated be withdrawn.

***III. Conclusion***

In view of the above amendment, applicant believes the pending application is in condition for allowance.

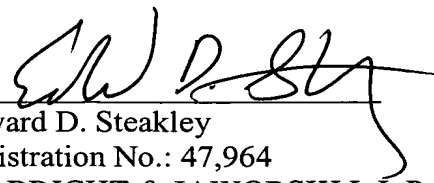
Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P01715US2 from which the undersigned is authorized to draw.

Application No.: 10/675,906

Docket No.: HO-P01715US2

Respectfully submitted,

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Attachments

**AMENDMENTS TO THE DRAWINGS**

Figures 3 and 4 have been labeled as prior art. A replacement sheet is submitted herewith.